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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/530,983	05/08/2000	GUSTAVO DECO	P000861	5072

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EXAMINER

OROPEZA, FRANCES P

ART UNIT PAPER NUMBER

3762

DATE MAILED: 10/06/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/530,983

Applicant(s)

DECO ET AL.

Examiner

Frances P. Oropeza

Art Unit

3762

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 10 September 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
(a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ they raise the issue of new matter (see Note below);
(c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____

Claim(s) objected to: _____

Claim(s) rejected: 1-18

Claim(s) withdrawn from consideration: _____

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

Angela D. Sykes
ANGELA D. SYKES

SUPERVISORY PATENT EXAMINER

FRANCES P. OROPEZA
ART UNIT 3762 10-1-03

Continuation of 5. does NOT place the application in condition for allowance because:

The Applicant's arguments filed 9/10/03 have been fully considered but they are not convincing.

The Applicant asserts the outstanding rejection appears to be primarily based on the obviousness of modifying Ravdin et al. to utilize a probability operation disclosed by Smyth. The Examiner disagrees. Ravdin et al. discloses a method for predicting the future occurrence of non-existent medical conditions, and Smyth is incorporated in the rejection to teach information flow describing a development of a predictability of plural future system states. Ravdin et al. focus on predicting the future state and Smyth focuses on information flow describing a development of a predictability.

In response to the Applicant's argument that the references fail to show certain features of the Applicant's invention, it is noted that the features upon which the Applicant relies (i.e. predicting the occurrence of an abnormal event) are not recited in the rejected claims(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). The Examiner finds the independent claims 1, 16, 17 and 18 include the limitation of "predicting an abnormality of a dynamic system" in the preamble.

In response to the Applicant's arguments, the recitation "predicting an abnormality of a dynamic system" has not been given patentable weight because the recitation occurs in the preamble; the recitation "predicting an abnormality of a dynamic system" is not positively recited in the body of the independent claims. The preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao* 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie* 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

The Applicant asserts it would not have been obvious to incorporate the references because Ravdin et al. predicts future outcomes and Smyth teaches a backward looking fault/abnormality predicting system. The Examiner disagrees. While Smyth teaches a backward looking fault/ abnormality predicting system for medical applications, Smyth also teaches predicting impending failure/ abnormality for medical applications (col. 2 @ 48-53, col. 6 @ 25-34; col. 8 @ 15-29; col. 22 @ 29-37), hence both Ravdin et al. and Smyth include a predictive feature for future/ impending events in medical conditions. The motivation of record to combine the references is deemed to be reasonable.

In response to the Applicant's argument that the references fail to show certain features of the Applicant's invention, it is noted that the features upon which the Applicant relies (i.e. decaying statistical dependencies, and the extent to which states of the system are predictable) are not recited in the rejected claims(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). The Applicant notes the Inventors describe "information flow" in articles written by Deco et al. as discussed in paragraph 2 of the specification. These articles do not appear to be incorporated by reference in the specification, hence the Examiner has not read information flow to be defined by

For the reasons noted above, the rejections of record stand.

The Applicant's claim for foreign priority and the submission of a certified copy of the foreign priority document, filed 5/8/00, is acknowledged.